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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,742	06/21/2001	Emerson Keith Colyer	IN-5486	6026

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

Office Action Summary	Application No. 09/886,742	Applicant(s) COLYER ET AL.	
	Examiner Tatyana Zalukaeva, PhD	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-17, 24-35 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/850,837. The only difference between claim 1 of No. '837 and the instant claim 1 is that the No. '837 recites alkyd resin. However, by the

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virtue of the word comprising each claim 1 allows even major components in even major amounts.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Molecular Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim clear coating composition comprising identical ingredients wherein the ranges of those components overlap with the ranges as instantly claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 1, 4-13, 15-18, 20-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jouck et al (U.S. 5,322,715)

Jouck discloses base coat composition, which contains an emulsion polymer as a film forming material. The basecoat coating compositions according to Jouck' invention may contain as pigments inorganic colored pigments such as, for example, titanium dioxide, iron oxide, **carbon black** etc., organic colored pigments as well as the customary metal pigments (for example, commercial aluminum bronzes, stainless steel bronzes . . .) and non-metallic effect pigments (for example nacreous luster pigments and interference pigments). The basecoat coating compositions preferably contain metal pigments and/or effect pigments. The degree of pigmentation lies within the customary range, preferably 0 to 10% by weight, based on the total weight of the basecoat coating composition (column 12, lines 34-46). The polymer of Jouck is prepared by two stage polymerization. In the first stage 10 to 90, preferably 35 to 65 parts by weight of an ethylenically unsaturated monomer or a mixture of ethylenically unsaturated monomers are emulsion polymerized (col. 5, lines 27-30). The first stage a1) 100 to 60, preferably 99.5 to 75% by weight of a cycloaliphatic or aliphatic ester of methacrylic acid or acrylic acid or a mixture of such esters and a2) 0 to 40, preferably 0.5 to 25% by weight of a monomer which is copolymerizable with (a1) or a mixture of such monomers (col. 5, lines 6-12).

Examples of monomers which can be used in the second stage, are as follows:

vinylaromatic hydrocarbons esters of the acrylic acid or methacrylic acid, in particular

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aliphatic and **cycloaliphatic acrylates or methacrylates** having up to 20 carbon atoms in the alcohol radical, such as, for example, methyl, ethyl, propyl, butyl, hexyl, ethylhexyl, stearyl, lauryl and **cyclohexyl acrylate** or 2-hydroxyethyl acrylate,

2-hydroxypropyl acrylate, 3-hydroxypropyl acrylate, 2-hydroxypropyl methacrylate, 3-hydroxypropyl methacrylate, etc. A mixture consisting of

(b1) 47 to 99, preferably 75 to 90% by weight of a cycloaliphatic ester of methacrylic acid or acrylic acid

(b2) 1 to 20, by weight of a monomer which is copolymerizable with (b1), (b3) and (b4) and carries at least one hydroxyl group or a mixture of such monomers

(b3) 0 to 8, preferably 2 to 6% by weight of a monomer which is copolymerizable with (b1), (b2) and

((b4) 0 to 25, preferably 2 to 15% by weight of a further monomer which is copolymerizable with (b1), (b2) and (b3) (col. 6, lines 1-20 and 26-46)

The emulsion polymer of Jouck has Mn higher than 200,000 (col. 6, lines 60-62) and hydroxyl number is 2-100 mg KOH /g (col. 6, lines 64, 65).

Further crosslinked polymeric microparticles can be added and/or customary inorganic or organic additives discussed in details in col. 12, lines 46-66.

Therefore the limitations of the instant claims 1, 4-13, 15-18, 20-35 are met by the disclosure of Jouck.

In the alternative this rejection is made in the sence of 35 USC 103(a), stating that the refinish property of the basecoat composition of Jouck will be either inherent or obvious to a person skilled in the art since the composition of Jouck is essentially the

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same the instantly claimed composition. The burden to show that this, in fact, is not the case is shifted to applicants as per *In re Fitzgerald* (205 USPQ 594). (CAFC) .

5. Claims 1-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Benefiel et al (U.S. 3,639,147).

Benefiel discloses a pigmented cellulose containing base coat composition (abstract). The base coat composition comprises a combination of a crosslinking agent and suitable carboxy-hydroxy acrylic copolymers are copolymers of 0.15 to 8 weight percent of a polymerizable monoethylenically unsaturated carboxylic acid, 3. 5 to 75 weight percent of a **beta-hydroxyalkyl ester of a polymerizable monoethylenically unsaturated carboxylic acid** and another different monomer polymerizable therewith. This copolymer preferably should include: 61. 0.15 to 8 weight percent (more preferably 0.15 to 4 weight percent) of an unsaturated aliphatic acid selected from at least one member of the group consisting of acrylic acid, methacrylic acid, crotonic acid, itaconic acid, and half acid-esters of maleic and fumaric acids formed with saturated alcohols having from one to 10 carbon atoms, 17 to 94.8 weight percent of at least one different ethylenically unsaturated monomer of the individual material selected in (1) which is copolymerizable with the unsaturated acid of (1) 83. 5 to 75 percent of a beta hydroxy alkyl ester of an unsaturated aliphatic acid selected from at least one member of the group consisting of acrylic acid, methacrylic acid, crotonic acid, and half acid-esters of the total of (1) (2) and (3) being 100 percent (col. 2, lines 61-75, col. 3, lines 1-12) Among monomers that can be copolymerized are cyclic esters of acrylates, such as cyclohexyl Methacrylate exemplified in col. 3, line 45.

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With regard to some properties of the base coat polymers that are not elucidated by the disclosure of Benefiel, these properties are believed to be inherent or obvious to a person skilled in the art, since the basecoat compositions of Benefiel are essentially the same as and are made by essentially the same process as instantly claimed compositions. The above rejections were made in the sense of *In re Fitzgerald* or *In re Spada*, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art.

Response to Arguments

6. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

Although the Rockrath reference applied in a previous rejection incorporates by reference the disclosure of Benefiel with regard to base coat composition in its entirety, the present rejection is not made final since these issues were not addressed in a previous rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva, PhD whose telephone number is (703)308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

TATYANA ZALUKAEVA
PATENT EXAMINER



January 10, 2003

Tatyana Zalukaeva, PhD
Primary Examiner
Art Unit 1713